

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/017, 929	02/03/98	BERNHARDT	D 8117-000021

HARNESS DICKEY & PIERCE  
P O BOX 828  
BLOOMFIELD HILLS MI 48303

QM21/0331

 EXAMINER

PIERCE, W

 ART UNIT

3711

 PAPER NUMBER

18

DATE MAILED: 03/31/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**

Application No. <b>09/017,959</b>	Applicant(s) <b>Bernhardt</b>
Examiner <b>William M. Pierce</b>	Group Art Unit <b>3711</b>

**THE PERIOD FOR RESPONSE: [check only a) or b)]**

a)  expires 3 months from the mailing date of the final rejection.

b)  expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

**Applicant's response to the final rejection, filed on Mar 8, 1999, has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:**

The proposed amendment(s):

will be entered upon filing of a Notice of Appeal and an Appeal Brief.

will not be entered because:

- they raise new issues that would require further consideration and/or search. (See note below).
- they raise the issue of new matter. (See note below).
- they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

\_\_\_\_\_

\_\_\_\_\_

Applicant's response has overcome the following rejection(s):

\_\_\_\_\_

\_\_\_\_\_

Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached.

\_\_\_\_\_

The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 1-16 \_\_\_\_\_

The proposed drawing correction filed on \_\_\_\_\_  has  has not been approved by the Examiner.

Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Other



**WILLIAM M. PIERCE**  
**PRIMARY EXAMINER**

Art Unit:

1. "The bowling ball" was never an antecedent issue. The scope of claim 1 is for an "accessory" and not the combination of a bowling ball. As set forth in the paper no. 4, the bowling ball "does not appear to be being claimed in combination". This is a scope of claim problem since the body of the claim must match the preamble. As to Stevens, if the examiner finds that a prior art element performs the function...the claimed limitation is anticipated by the prior art element. The burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure... *In re Mulder* , 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). Applicant relies on functional limitations and statements of intended use and has failed to show where the claims structurally distinguish over the applied art.
  
2. Any inquiry concerning this communication should be directed to William Pierce at E-mail address [bill.pierce@USPTO.gov](mailto:bill.pierce@USPTO.gov) or at telephone number (703) 308-3551.



WILLIAM M. PIERCE  
PRIMARY EXAMINER